REMARKS

In the Office action mailed May 13, 2003 the drawings were objected to, claims 1-10, 13, and 16-21 were rejected under 35 USC § 103 based on U.S. Pat. Number 5,983,010 to Murdock et al. ("Murdock") in view of EP051368 to Nielsen et al. ("Nielsen"), and claims 11-12 and 14-15 were rejected under 35 USC § 103 based on Murdock and Nielsen further in view of U.S. Patent No. 6,446,053 to Elliot ("Elliot.").

In response to the objection to the drawings, applicants hereby attach revised Figures 1-3, with corrected margins.

Applicants respectfully disagree with the Examiner's rejections of claims 1-21 based on combinations of Murdock, Nielsen, and/or Elliot. In order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a) the Examiner must show (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available at the time of the invention to one of ordinary skill in the art; (2) that there is a reasonable expectation of success, and (3) that the prior art references teach or suggest all of the claim limitations. The teaching or suggestion to combine the references must be found in the prior art, and not in applicants' disclosure, or else the Examiner engages in impermissible hindsight reconstruction. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The U.S. Court of Appeals for the Federal Circuit has held such a combination of references unacceptable, noting that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fitch, 23 USPQ2d 1780, 1784 (1992).

<u>Claims 1-3</u>

Turning initially to the rejection of claim 1 based on Murdock and Nielsen, the Examiner has not established a prima facie case of obviousness because (1) there is no suggestion or motivation for combining the references, neither in the references themselves nor in the knowledge of one of ordinary skill in the art, (2) there is no reasonable expectation of success, and (3) that the prior art references teach or suggest all of the claim limitations.

Under MPEP § 2143.01 and established case law, when evaluating whether there is sufficient suggestion or motivation to combine references, Examiner's must consider, among other factors, whether the prior art suggests the desirability of the claimed invention, whether the proposed modification renders the prior art unsatisfactory for its intended purpose, and whether the proposed combination changes a principle of operation of a reference. See In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The mere fact that the references can be combined is not sufficient. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Murdock discloses a system having a house structure generator computer program 60 and an energy simulation computer program 82. In stark contrast, Nielson discloses a HTML/JAVA-based text searching technology, in which a text searching interface is served from one computer to another, through use of HTML/JAVA. The technologies of Murdock and Nielson are completely different, and either reference contains any mention of the desirability of combining the other. Specifically, Murdock makes no mention of the

desirability of having a JAVA-based text searching interface, nor does Nielson make any mention of the desirability of including a house structure generator 60 or an energy simulation computer program 82. Further, it would not have occurred to one of ordinary skill in the art to combine Murdock and Nielson, because house-structure generation and energy estimation have absolutely nothing to do with JAVA based text searching tools. Murdock doesn't include any mention whatsoever of the need for text searching in its house structure generation or energy estimation. Nor, as discussed below, does the claimed invention. Thus, Applicants respectively submit that Murdock and Nielson references are improperly combined.

Regarding expectation of success in combining the references, applicants respectfully submit that since Murdock contains no discussion of text searching whatsoever, it would not have been reasonable to expect a successful combination of the JAVA based text searching technology of Nielson with the house structure generation and cost estimation of Murdock.

Importantly, the two cited references do not disclose or suggest each of the claim limitations for claim 1. The Examiner admits in the Office action that Murdock does not disclose the following steps (f)-(h).

f) receiving a profile inquiry into an application engine, the application engine included within the interactive profile system, the profile inquiry received from a user, and the profile inquiry relatable to the enhanced profile database;

g) formulating a profile response to the profile inquiry with the application engine, the profile response including a listing of at least one of the plurality of interrelated elements of the enhanced profile; and

h) sending the profile response to the profile query to the user.

Applicants respectfully submit that the Examiner's assertion that these elements are disclosed by Nielsen is incorrect. The Examiner cites the Abstract, Figs. 3 and 4, as well as claim 1, at Page 9, lines 39 et seq. reprinted below, and asserts that these passages disclose the above limitations. The abstract and the cited portion of claim 1 are reprinted below.

1. Apparatus for carrying out a search of a database, comprising:

    a. a computer, having a search process for searching said database, configured to send a graphical user interface to a user device, said graphical user interface including text entry and/or operator components and a single string interpretation of a text query formulated using said components of said graphical user interface; and

    b. a user device, including a display, connected to said computer for displaying said graphical user interface.

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Nielson, Page 9, Lines 36-43

(57)   A graphical user interface (GUI) for a text search system includes text entry fields and menus of operators from which a search query is composed. The actual search query submitted to a search engine is a single string of text and operators arranged in accordance with the search syntax in use. The actual search query is also displayed on the GUI and permits a user to learn how the system interprets the entries in the fields and selections from the menus as they are entered or changed. The displayed search query is also editable and changes in the overall search query are reflected back into the text entry fields and operators from which it was composed. Thus a user can compose a search query using either form fill out or text editing.

Nielson Abstract

After careful review of these passages, as well as the Nielson reference in its entirety, applicants respectfully submit that Nielson is directed to a completely different field, text searching using a JAVA enabled web page, and makes no mention whatsoever of receiving a profile inquiry that is relatable to an enhanced profile database of interrelated building components of a structure. Further, nowhere in Nielsen is any disclosure made regarding formulating a profile response including a <u>listing</u> of at least one of the plurality of interrelated building components of the enhanced profile. Applicants respectfully submit that only the Examiner's impermissible hindsight reconstruction has read the elements of steps (f)–(h) into the Nielson reference.

In view of the above, applicants submit that Claim 1 is allowable, as are dependent claims 2 and 3.

Claims 4-5

Claim 4 has been amended to include the following elements:

wherein the profile query is relatable to the enhanced profile database; and
wherein the application engine is configured to formulate a profile response to the profile query, the profile response including a listing of at least one of the plurality of interrelated elements of the enhanced profile, and is further configured to send the profile response to the user via the web browser.

For the reasons stated above with regard to claim 1, applicants submit that Murdock and Nielson are improperly combined, and do not, either alone or in combination, disclose each of the elements in amended Claim 4. Therefore, claim 4 and its dependent claim 5 are believed allowable.

Claims 6-8

Claim 6 includes elements (f)–(h), which are similar to elements (f)–(h) in claim 1. For the reasons discussed above with regard to claim 1, applicants believe that the combination of Murdock and Nielson is improper, and fails to disclose all of the elements of claim 6. Therefore, claim 6, and its dependent claims 7-8, are believed allowable.

Claims 9-21

Regarding Claim 9, Applicants reiterate and reincorporate the above discussion regarding the improper combination of Murdock and Nielson, and the lack of any reasonable expectation of success of the combination. Applicants further submit that the combination of Murdock and Nielson fails to disclose each of the elements of claim 9. Applicants initially note that, neither reference specifically discloses receiving a plan set including a two dimensional physical description of a building, and developing a three-dimensional physical description of the building based on this plan set.

In addition, claim 9 includes the following elements, which the Examiner admits Murdock fails to disclose.

> providing access to the enhanced profile database via a computer network from a remote location;
> receiving a user profile query at the enhanced profile database requesting information based on the building components of the building profile; and
> sending a profile response to the user at the remote location, the profile response being based on the building components

The Examiner asserts that Nielson discloses these steps, citing the Abstract and Claim 1, reprinted above, as well as the following passages at Page 5, Lines 54-57.

Figure 2 represents an exemplary graphical user interface in accordance with the invention. The graphical user interface shown in **Figure 2** has a plurality of text entry fields **200** for receiving respective strings of characters for construction of a search. A plurality of operators can be invoked using pull down menu areas **210**. Each memory area **210** contains a display area for displaying the operator currently selected and a pull down memory activation area **220**

Nielson, Page 5, Lines 54-57

Despite these assertions by the Examiner, careful review of these passages reveals they relate to a JAVA interface for text searches. Neither the cited passages, nor any other portion of the Nielson references makes any mention whatsoever of providing access to an enhanced profile database containing a plurality of enhanced profiles including interrelated building components. Further, no disclosure is made of receiving a profile query requesting information based on the building components contained in the enhanced profile database. Finally, no disclosure of any kind is included on sending a profile response that is based on the building components, to the remote user. The applicants respectfully assert that only the Examiner's impermissible hindsight reconstruction has read these limitations into the Nielson reference.

In view of the above, applicants believe that all of the limitations of claim 9 are not disclosed in the combination of Murdock and Nielson. Therefore, claim 9, and its dependent claims 10-21, are believed allowable. Regarding the rejection of claims 11-12 and 14-15 based on Elliot, applicants believe that the these claims are allowable with claim 9, irrespective of the Elliot reference. Nevertheless, applicants traverse the Examiner's assertions regarding the disclosure of Elliot reference.

The above amendments and remarks are believed to address fully the Examiner's

rejections, and place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

Respectfully submitted,
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